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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,382	11/15/2000	Clayton A. George	54680USA8B.008	4594

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04/03/2002

Office of Intellectual Property Counsel
3M Innovative Properties Company
P O Box 33427
St. Paul, MN 55133-3427

EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 04/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/713,382	GEORGE ET AL.	
	Examiner	Art Unit	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3,4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The parent case 09/409520, and the issued US Patent No. 6316099 are not properly referenced.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 11-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-10, 12-16, 18-25, 28-32, 34-42 of U.S. Patent No. 6284360 in view of Sekisui Chemical Co. (JP 10195393).

Johnson shows all the features of the instant claimed invention except for the specific difference in the curing rate of the bulk layer and the adhesive layer. Sekisui '393 discloses a curable pressure sensitive adhesive sheet and a method for bonding members. Sekisui '393 teaches that an excellent initial adhesive strength can be obtained by laminating photocurable pressure sensitive adhesive layers, which contain

a mixture of a sticky polymer (such as an acrylic polymer) and an epoxy adhesive compound, with different curing rates (Abstract). As such, in the absence of unexpected results, it would be obvious to one of ordinary skill to modify the sealant layer of Johnson with the layered adhesive structure, as taught by Sekisui '393, motivated by the desire to obtain an excellent initial adhesive strength imparted by the difference in curing rates.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being obvious over Johnson et al. (US 6284360) in view of Sekisui Chemical Co. (JP 10195393).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Johnson's invention is directed to a multi-layered article which may be provided in the form of a tape which comprises a conformable, compressible, melt flow-resistant core layer having first and second major surfaces, a sealant layer on the first major surface of the core layer, and optionally a bonding layer on the second major surface of the core layer. The sealant layer and the bonding layer each have a surface available for contacting a separate substrate. Various thermoset and foam core layers are disclosed as are thermosettable and thermoplastic sealant layers. The articles are useful for sealing two substrates together, particularly where one of the substrates is glass. Thus, the articles are especially adapted for sealing motor vehicle windshields to a frame. Various assemblies and methods for producing the same are also described (Abstract). Examples of suitable core layers include foams, which may be open or closed cell foams, although closed cell foams are preferred. Examples of suitable foams include polyacrylic, polyurethane and polyolefin foams. Also useful are core layers in the form of pressure sensitive adhesives, e.g., pressure sensitive adhesive foams (column 3, lines 42-49). Various multi-layered sealant or tape structures and assembled constructions are illustrated in Figs. 1-8. In one embodiment, the thermosettable sealant layer includes a blend of (a) an epoxy resin, (b) a resin selected from the group consisting of polyacrylates, semi-crystalline polyesters, and combinations thereof, and (c) a curing agent selected from the group consisting of (i) thermally activated curing agents characterized by a thermal activation temperature and (ii) photo-active curing agents characterized by a thermal decomposition temperature (column 2, lines 47-54). In another embodiment, the thermosettable sealant layer

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substantially retains its shape when heated to a temperature greater than the softening temperature of the composition, but less than about 200°C., until acted upon by an external force other than gravity (column 2, lines 55-59). Johnson shows all the features of the instant claimed invention except for the specific difference in the curing rate of the bulk layer and the adhesive layer. Sekisui '393 discloses a curable pressure sensitive adhesive sheet and a method for bonding members. Sekisui '393 teaches that an excellent initial adhesive strength can be obtained by laminating photocurable pressure sensitive adhesive layers, which contain a mixture of a sticky polymer (such as an acrylic polymer) and an epoxy adhesive compound, with different curing rates (Abstract). As such, in the absence of unexpected results, it would be obvious to one of ordinary skill to modify the sealant layer of Johnson with the layered adhesive structure, as taught by Sekisui '393, motivated by the desire to obtain an excellent initial adhesive strength imparted by the difference in curing rates.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interested for multilayer sealant:

US 6316099 to George et al.

US 5137770 to Rothe et al.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Vsc

VSC

April 1, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zinker